



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,013	02/28/2006	Kei Yoshida	PREZP102US	5278

23623 7590 12/19/2008
AMIN, TUROCY & CALVIN, LLP
127 Public Square
57th Floor, Key Tower
CLEVELAND, OH 44114

EXAMINER

KUMAR, SHAIENDRA

ART UNIT	PAPER NUMBER
----------	--------------

1621

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/19/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket1@thepatentattorneys.com
hholmes@thepatentattorneys.com
lpasterchek@thepatentattorneys.com

Office Action Summary	Application No. 10/570,013	Applicant(s) YOSHIDA ET AL.	
	Examiner SHAIENDRA -. KUMAR	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-8, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/28/06, 7/10/07, 9/20/07, 11/28/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicants' communication filed on 9/11/08.

Claims 1-21 are pending in this application.

Applicant's election with partial traverse of Group I, claims 1-8 and 17-18 in the reply filed on 9/11/08 is acknowledged. The traversal is on the ground that Groups 2-5 and 8 can be deemed within the same group as Group 1. More specifically, Group 1 relates to a compound of Formula (1), Groups 2-4 relate to an intermediate of the compound of Formula (1), Group 5 relates to a method of making the compound of Formula (1), and Group 8 relates to a method of using the compound of Formula (1). Consequently, Groups 1-5 and 8 have a common characteristic of the compound of Formula (1) and have unity in accordance with the PCT unity rules. PCT Unity is satisfied when 1) multiple inventions have unity when the inventions have the same or corresponding special technical features, and 2) the special technical features are common features that define the inventions over the prior art. In this case, the compound of Formula (1) is the special technical feature. At the very least, Groups 1, 5 and 8 have a common characteristic of the compound of Formula (1) and have unity in accordance with the PCT unity rules.

This is not found persuasive because the generic structure of the claimed compounds are very broad and are chemically disparate, so as to lacking the corresponding special technical feature. A search of the entire application, or for the groups as recommended by applicants would place undue burden on the PTO. Claims 9-16 and 19-21 stand withdrawn, being drawn to the non elected subject matter.

The requirement is still deemed proper and is therefore made FINAL.

Also acknowledged is the species of example 130. Claims 1-8 and 17-18 will be examined to the extent they read on the elected species and closely related compounds, Encompassing the elected species.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 2/28/06, 7/10/07, 9/20/07 and 11/28/07 are in compliance with the provisions of 37 CFR 1.97.

Accordingly, the information disclosure statements have been considered by the examiner.

3. The elected species is free of prior art.

4. Claims 1-8 and 17-18 are objected to as containing subject matter that is drawn to the non elected subject matter, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, encompassing the elected species and closely related compounds.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on (571)272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAIENDRA - KUMAR/
Primary Examiner, Art Unit 1621

S. Kumar
12/15/08